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BAKER BOTTS LLP, 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			NGUYEN, THUY-VI THI	
		ART UNIT	PAPER NUMBER	
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		08/05/2010		ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/775,368	<b>Applicant(s)</b> STASHLUK ET AL.
	<b>Examiner</b> THUY-VI NGUYEN	<b>Art Unit</b> 3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 May 2010.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,7-22,24-28 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,7-22,24-28 and 30-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/10/10 has been entered.
2. This is in response to the applicant's communication filed on 06/10/10 wherein:  
Claims 1-5, 7-22, 24-28, 30-35 are currently pending;  
Claims 1, 7-14, 16-18, 24-28 have been amended;  
Claims 6, 23 and 29 have been cancelled;  
Claims 33-35 have been added.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-5, 7-22, 24-28, 30-35** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 1 recites the limitation "the machine readable code" in the last step. There is insufficient antecedent basis for this limitation in the claim. There are two different "machine readable code" on the return shipping label as recited in the previous

steps. Thus, it is not clear which one will be scanned by the merchant or by the specialized return center as indicated in the last step.

2) Claim 1 recites the limitation "a merchant associated with the transaction", it's not clear whether "a merchant" is preferred back to "the merchant" as recited in the previous step, or it is introduced another entity?

3) Claims 14 and 28 are rejected for the same reason sets forth rejected independent claim 1 above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-22, 24-28, 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over TSUNENARI ET AL (US 2002/0013744) in view of RAMING (US 6,616,189) and further in view of official notice.

**As for claim 1**, TSUNENARI ET AL. discloses a computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a transaction, comprising the steps of:

- 1) accessing item data representing at least one detail about the item

{see at least figures 9-10g; 10i; pars. 0013; 0075, lines 1-23 discloses information about the product/item to be returned}

2) accessing transaction data representing at least one detail about the transaction associated with the item;

{see at least figures 4, 10G, 10K; pars.0034; 0075; 0083 disclose product transaction associate with the item}

3) accessing customer data representing at least one detail about a customer associated with the transaction

{see at least figures 10C, 10G, 10I, 10K; and pars. 0072, 0075, 0080-0081

4) accessing package data representing at least one detail about the package in which the item is expected to be shipped

{see at least figures 10I; 0061; 0116 discloses shipping package data}

5) using a computer operated by the merchant/manufacturer from whom the item was acquired to correlate the item data, transaction data, customer data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center

{see figures 1-3; pars. 0060-0063; 0080-0081; 0092-0094 discloses the merchant/manufacturer web server correlate the returned product information and customer information using the business rules to determine the coding to be printed on

a return shipping label, e.g. based on the receiving particular returned product information from customer, *the server will determine the destination of the product in accordance with the product type sending the product to a facility at which it may be processed. the destination is defined in accordance with the location of the customer, selecting whatever suitable destination is closest to customer in order to minimize cost* (par. 0060); *determine which carrier service is the most economical, given the nature of the product to be returned (such as its weight and dimension) and the pickup delivery points* (par. 0061); *Once the destination and a carrier service are selected, the Web server generates shipping label data. The shipping label include data sufficient for the client/consumer computer to direct a printer to print a shipping label that includes an identification of the destination and the carrier service selected, and also data necessary to print an actualization code on the label* (par. 0062-0063); *and the selection of the product destination is made by the manufacturer server on the basis of specified rules that take into consideration the geographical location of the customer and the nature of the product being returned (see pars. 0092-0093)).*

6) using the computer operated by the merchant/manufacture from whom the item was acquired to generate machine readable code for the return shipping label for shipment from the customer to the return center (return facility),

{see figures 10I; pars. 0062-0063; 0081 discloses generating the shipping label as the results of the correlating step (recited item data, transaction data, customer data and package data), and the label also includes the machine readable code which contain information used by the carrier for the pick up and tracking of the parcel};

7) using the computer operated by the merchant/manufacture web server to format the return shipping label and complies with shipping labels specification of the choice of carrier, and a carrier specified machine readable code present on the shipping label

{see figure 10I; 10J, pars. 0061; 0081-0082 discloses formatting the returning shipping label, and the shipping label also complies with shipping label specifications of the choice of carrier by (determine which carrier service is the most economical, given the nature of the product to be returned, and the pick up and delivery points)}.

**Note:** for convenience, numbers (1)-(7) are added to the beginning of each step.

TSUNENARI ET AL discloses the claimed invention as indicated above except for the type of information/data points in the machine readable code of the shipping label representing at least the shipping origin of the package and the identification of the transaction; scanning the machine readable code to correlate the machine readable code with one or more business rules for performing returning processing for a merchant associated with the transaction (part of steps 2 and 3, steps 6-8).

In the similar method for generating and transmitting electronic shipping label including a barcode, SAVINO ET AL discloses a machine readable barcode included in a shipping label for coordinating shipping and receiving information between supplier and customers in order to reduce the time consuming and costly. A bar code value represents plurality of predetermined relevant purchase and shipping information associated with a purchase order such as customer name and address, packing slip number, customer purchase order number (identification transaction), part/item quantity

number, customer part number, shipping information. The bar code can be scanned by a supplier/merchant to retrieve from the database all relevant purchase and shipping information associated with a purchase order {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54, col. 4, lines 24-35}.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of **TSUNENARI ET AL** to include the shipping label contains the machine readable code which represents customer address and identification of the transaction as taught by **SAVINO ET AL** for coordinating shipping and receiving information between supplier/merchant and customers in order to reduce the time consuming and costly.

Note: As for the data point about customer data such as "a shipping origin" is included in the machine readable code as recited in the claim invention. Since TSUNENARI ET AL/ SAVINO ET AL discloses the machine readable code represents various variables or aspects of purchase and shipping information of a purchase order such as customer name and address, packing slips number, part quantity number, customer part number, etc. {SAVINO ET AL at least figures 4-5, col. 3, lines 34-48; col. 4, lines 20-35}, therefore, SAVINO contemplates that the machine readable code can include other data value. Official notice is taken that shipping origin information is well known to be included in shipping label. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the data value "shipping origin" into the machine readable bar code of Tsunenari/ Savino to provide more complete variables or aspects of purchase and shipping information.

**As for dep. claims 2-5** which discloses the information/data about the items and the transaction, customer information, package information, this is taught in TSUNENARI ET AL {see figures 10G-10, and figures 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 7**, which discloses the customer preferences/data comprising a customer selected choice of carrier, and format the return shipping label as required by the customer selected choice of carrier this is taught in TSUNENARI ET AL {see at least fig. 10i-10j, pars. 0062-0063}

**As for dep. claims 8-11**, which discloses scanning the machine readable code to identify the merchant as the payee of shipping charges, TSUNENARI ET AL/SAVINO discloses the shipping label data include an actualization code on the label indicating that the shipping of the package on which the label is affixed has been pre-authorized and that the receiver (merchant/manufacturer) will pay the shipping costs {see TSUNENARI ET AL, par. 0062, figure 10i}}; calculating or determining the shipping charge due to the carrier based on the cost of shipping package, package weight, the package size, shipping rate and the cost of shipping package from the shipping origin associated with the customer to the merchant/manufacturer {see TSUNENARI ET AL, pars. 0061-0062, 0092 figure 10 i}.

**As for dep. claims 12-13**, which discloses carrier data location data, format the return shipping label to include the carrier center location closest to the merchant or

return center as the shipping destination, this is taught in TSUNENARI ET AL {see at least figures 10 i-10j, and figures 12, 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 33,** TSUNENARI ET AL/SAVINO discloses receive a return product and provide returns processing for plurality of merchants; {see TSUNENARI ET AL at least figures 14-15, pars. 0113, 0115, 0119-0120}; a data value represents the identification of the merchant in the machine readable code and scanning the machine readable code in response to receiving the package containing the item for return to identify the merchant associated with the transaction {see SAVINO at least figures 4-5, col. 3, lines 34-48; col. 4, lines 20-35}.

**As for independent claim 14,** which discloses software embodied in a memory and comprising programming operable when executed by a computer to carry the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim 1 as stated above.

**As for dep. claim 15,** which discloses the accessing the group of information/data such as item data, customer data, transaction data via a remote data communication link, this is fairly taught in TSUNENARI ET AL {see figures 10G-10I, and figures 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 16,** which discloses the shipping rate, and determine/calculate the shipping charge based on the shipping rate data and the cost of shipping the package from the shipping origin associated with the customer to the merchant/manufacture {see TSUNENARI ET AL, pars. 0061-0062, 0092, 0102 figures 10i and 12}.

**As for dep. claims 17-18**, which discloses carrier data location data, format the return shipping label to include the carrier center location closest to the merchant or return center as the shipping destination, this is taught in TSUNENARI ET AL {see at least figures 10 i-10j, and figures 12, 14-15; pars. 0060-0063; 0075}.

**As for dep. claim 19-22** which carry the similar limitations as dep. claims 2-5 above. They are rejected for the same reason sets forth dep. claims 2-5 as indicated above.

**As for dep. claims 24-27**, which carry similar limitations as dep. claims 7-10 above. They are rejected for the same reason sets forth dep. claims 7-10 as indicated above.

**As for dep. claim 34** which carry similar limitations as dep. claim 33 above. They are rejected for the same reason sets forth dep. claim 33 as indicated above.

**As for independent claim 28**, which discloses a software embodied in a memory and comprising programming operable when executed by a computer to carry the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim as stated above.

**As for claim 30**, TSUNENARI ET AL discloses a business rules is used to access package data representing at least one detail about the package in which item is expected to be shipped {see figures 10G-10I; pars. 0075; 0080-0082; 0092-0093}

**As for dep. claims 31-32**, TSUNENARI ET AL discloses the shipping information include the choice of carrier and package information, {see figures 10G-10I; pars. 0060-0063; 0080-0081. 0092-0093}.

**As for dep. claim 35** which carry similar limitations as dep. claim 33 above.

They are rejected for the same reason sets forth dep. claim 33 as indicated above.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-5, 7-22, 24-28, 30-33 have been considered but are moot in view of the new ground(s) of rejection based on the amended language.
7. The examiner asserts that the reference of SAVINO also had used to reject the claims which filed on 11/19/09. However, the examiner has re-applied the reference of SAVINO to reject on claims 1-5, 7-22, 24-28, 30-33 due to the amended language filed on 05/17/10.

In response to Applicant's argument on page 13 of the remark file on 11/19/09, Applicant stated that SAVINO only teaches a way from a shipping label that includes more than one bar code since SAVINO only discloses a shipping label that includes a single bar code. However, this is not persuasive. SAVINO discloses a system of employing a single bar code provided on a shipping label for coordinating shipping and receiving information between supplier and customer, whereby data value in the single bar code represents a purchase and shipping information of a purchase order such as customer name and address, packing slip number, customer purchase order number and etc {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54, col. 4, lines 24-35}. This single bar code is scanned and used by the supplier or customer for coordinating shipping and receiving information, but does not provide for the actual

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delivery. There is not specific provision for postage, package weight or other data typically employ by a carrier for delivery {see SAVINO col. 1, lines 59-67; col. 2, lines 1-6}. Thus, the single bar code of SAVINO could not be the only bar code on the package being delivered. The package being delivered may also contain another machine readable code that being used by a carrier for delivery.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

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